

Remarks

Claims 4-6, and 19-43 are pending. 4-6 and 19-31 are rejected. Claims 20, 26, and 29 have been amended. New claims 32-49 have been added. Reconsideration of the claims is requested in light of the following remarks. No new subject matter has been added.

***Premature Final Rejection***

Applicant respectfully requests that the Examiner withdraw the final rejection. With regard to at least claim 6 the Examiner introduced a new ground of rejection/argument based on newly cited Pohn that was neither necessitated by applicant's amendment of claim 6, nor based on information submitted in an information disclosure statement (see MPEP 706.07(a) second paragraph). The new ground of rejection was not necessitated by the applicant's amendments to claim 6 because the applicant's amendments were clarifying amendments for the Examiner's benefit that did not change the substantive scope of claim 6.

For example, the Examiner stated in an office action dated February 27, 2003 that claims 4-6 given the broadest reasonable interpretation would cover border cling. The applicant responded in a July 27, 2004 response to an office action with regard to claim 4 that claim 4 would not cover border cling because, for example, claim 4 includes a *privacy feature* such that "objects on either side of the window cannot be clearly distinguished from the other side". A window that is not entirely covered would not operate such that objects on either side of the window cannot be clearly distinguished; therefore this element requires that the film cover the entire window.

The applicant pointed out that border cling does not teach or suggest this *privacy feature* since border cling does not cover the whole window and the uncovered portions of the window would allow objects to be clearly distinguished from the other side. For the Examiner's benefit and without changing the scope of the claim, the applicant then clarified this *privacy feature* with regard to claim 6 by including that the individual pieces fill "an entire surface of the window" (to form a window covering).

Thus, since claim 6 already featured a window covering covering an entire window per the language referencing the *privacy feature*, the applicant's amendment was solely a clarification for the Examiner's benefit that did not change the scope of claim 6. Other clarifications also did not change the scope of the claim and were included only for the Examiner's benefit.

Thus, since the Examiner's new rejection based on newly cited Pohn was neither necessitated by applicant's amendment, nor based on information submitted in an information

disclosure statement, the application respectfully requests that the Examiner withdraw the final rejection (see MPEP 706.07(a) second paragraph).

Furthermore, referring to MPEP 706.07, a final rejection should generally not be made when a new reference is cited in a rejection. See MPEP 706.07, "[b]efore final rejection is in order a clear issue should be developed between the applicant and [the Examiner]... [s]witching ... from one set of references to another by the Examiner in rejecting in successive actions claims of *substantially the same subject matter*, will alike tend to defeat attaining the goal of reaching a clearly defined issue for ... a final rejection." A clear issue has not been developed at least with regard to claim 6 because Pohn was newly cited by the Examiner. Furthermore, and as explained previously, the subject matter of claim 6 had remained *the same subject matter* when the Examiner introduced a new rejection based on the new Pohn reference.

#### ***Claim rejections – 35 USC 103***

Claim 4 has been rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 4,528,232 to Cliffe (hereinafter Cliffe) in view of U.S. Patent No. 5,672,413 to Taylor et al. (hereinafter Taylor et al.). This rejection is respectfully traversed.

The combination of Cliffe and Taylor do not teach each and every element of claim 4 for at least the reason that the combination does not teach or suggest the element of the film allowing light to pass through but diffusing it so that objects on either side of the window *cannot be clearly distinguished from the other side of the window*. Cliffe teaches an anti-glare device that is applied to an upper portion of a windshield. Since the anti-glare device is applied only to an upper portion of a windshield, the remaining portion of the windshield remains completely clear and therefore objects *can* be clearly distinguished from one side of the windshield to the other. Therefore, Cliffe does not teach the element of the film allowing light to pass through but diffusing it so that objects on either side of the window *cannot be clearly distinguished from the other side of the window*. Additionally, Taylor does not teach or suggest this element. The combination of Taylor and Cliffe would thus only teach a colorful anti-glare device and would not teach the process of producing a *window covering* claimed in claim 4. The combination would not teach the claimed *privacy feature*. A prima facie case of obviousness based on Taylor and Cliffe has thus not been established.

Claims 4, 5 and 19-21 have been rejected under 35 USC § 103(a) on the basis of U.S. Patent No. 6,030,002 to Charley et al. (hereinafter Charley et al.), in view of Taylor et al., in view of Cliffe, further in view of U.S. Patent No. 6,054,208 to Rega et al. (hereinafter Rega et

al.) and GB2324381, and further in view of the advertisement for Solar Stat. This rejection is respectfully traversed.

The combination of Charley, Taylor, Cliffe, Rega, GB 2324381, and Solar Stat fail to teach or suggest each and every element of claim 4. The combination of the references fails to teach at least the element of the film allowing light to pass through but diffusing it so that objects on either side of the window *cannot be clearly distinguished from the other side of the window*. The claimed process of producing a window covering results in a window covering that is specifically designed to allow light in but deny visibility from either side (see page 5 of the present specification, the last paragraph of the background section, also see page 5 object (h)). Accordingly, claim 4 includes the feature that objects on either side of the window *cannot be clearly distinguished from the other side of the window* and this feature is neither taught nor suggested in any of the references.

Each and every one of the references fails to teach or suggest this important feature of claim 4. First, Charley fails to teach or suggest this element. Charley teaches only applying film to the border of a window leaving nearly the entire window uncovered for viewing. Thus, in Charley, objects on either side of the window *can* be clearly distinguished from the other side of the window. A window using the products disclosed in Charley would not afford privacy. Charley teaches away from privacy by intentionally covering only the border of the window and leaving the middle of the window clear.

Second, Taylor does not disclose or suggest this element as Taylor discusses only printing images generally and does not discuss the uses of the resulting images.

Third, Cliffe teaches an anti-glare device that is applied to an upper portion of a windshield. As the applicant explained in the July 27, 2004 response to office action, the device disclosed in Cliffe specifically instructs applying the anti-glare device so that objects on either side of the windshield *can* be clearly distinguished from the other side of the windshield. Cliffe accomplishes this by applying the anti-glare device only to an upper portion of the windshield leaving the majority of the windshield uncovered for viewing. A window using the products disclosed in Cliffe would not afford privacy. Cliffe teaches away from privacy by intentionally covering only the border of the window and leaving the middle of the window clear.

Forth, Rega does not disclose or suggest this element as Rega discusses only forming images on film generally without discussing the uses of the resulting film.

Fifth, GB 232438 does not disclose or suggest this element as GB 232438 does not disclose or suggest even apply film to a window. It is arguable whether GB 232438 is even applicable prior art.

Sixth, as discussed in the specification or the present application (last two paragraphs of the background of the invention section), Solar Stat does not disclose or suggest this element. Solar Stat is intended to block harmful UV rays and *allow* transparency so the *view through the window is largely unaffected*. Also, see Solar Stat where it only offers only "some privacy". Furthermore, see Solar Stat where it discusses applying the product to auto glass, therefore clearly implying that it does not substantially affect view. For example, the product would not be applicable to auto glass if it did substantially affect a view because said auto would leave a driver nearly blind on the road. A window using the products disclosed in Solar Stat would not afford privacy.

Each of the six references the Examiner has applied in this rejection actually *teach away* from the claimed limitations where objects on either side of the window *cannot be clearly distinguished from the other side of the window*. Each reference specifically designs the products so that objects *can* be clearly distinguished from either side of the window. Each reference discloses products or processes of creating products that are *designed with the intention* of leaving the viewing function of the window intact. Each reference accomplishes this design intention in different ways (i.e. leaving part of the window uncovered, applying highly translucent tint, etc.) None of the references, for example, would be adequate for creating a product designed to cover a bathroom window. Any product created according to the references or according to combinations of the references would allow viewers on the outside of the bathroom to look in and observe people inside the bathroom. In contrast, the film of claim 4 when applied to a bathroom window would prevent an outside viewer from observing people inside the bathroom.

Claim 19 should be allowable for at least similar reasons as claim 4. Claim 20 is dependent on claim 19 and should be allowable for the reasons given above in support of its parent claim 19. Claim 20 has also been amended to clarify that a large amount of light passes through the window covering. Charley does not allow a large amount of light to pass through the window border because an opaque layer is added to the window border preventing a large amount of light to pass through the border.

Claim 21 should be allowable for at least similar reasons as claim 4. Claim 22 is dependent on claim 21 and should be allowable for the reasons given above in support of its parent claim 21.

Claims 6, 23, 26, 27, 29 and 31 have been rejected under 35 USC § 103(a) on the basis of U.S. Patent No. 6,030,002 to Charley et al. (hereinafter Charley), in view of U.S. Patent No. 4,791,745 to Pohn (hereinafter Pohn) and U.S. Patent No. 4,582,232 to Cliffe (hereinafter Cliffe), further in view of U.S. Patent No. 6,054,208 to Rega et al. (hereinafter Rega) and GB2324381, and further in view of the advertisement for Solar Stat, and further in view of U.S. Patent No. 5,258,214 to Cooledge et al. (hereinafter Cooledge). This rejection is respectfully traversed.

The combination of Charley, Pohn, Cliffe, Rega, GB 2324381, Solar Stat, and Cooledge fail to teach or suggest each and every element of claim 6. The combination of the references fails to teach at least the element of the film allowing light to pass through but diffusing it so that objects on either side of the window *cannot be clearly distinguished from the other side of the window*. The claimed process of producing a window covering results in a window covering that is specifically designed to allow light in but deny visibility from either side (see page 5 of the present specification, the last paragraph of the background section). Accordingly, claim 4 includes the feature that objects on either side of the window *cannot be clearly distinguished from the other side of the window* and this feature is neither taught nor suggested in any of the references.

Each and every one of the references fails to teach or suggest this important feature of claim 6. Charley, Taylor, Cliffe, Rega, GB 2324381, and Solar Stat each fail to teach or suggest this element for the reasons described previously in this response to office action with regard to claim 4.

Additionally, Pohn fails to teach or suggest this element. In Pohn, a disclosure to apply a vinyl decal to a backlight lit acrylic sheet of an advertisement is offered. Pohn does not even disclose a window. It is arguable whether Pohn is even applicable prior art. Even if Pohn is applicable prior art, Pohn does not teach or suggest the element that objects on either side of the window *cannot be clearly distinguished from the other side of the window* for at least the reason that Pohn does not discuss windows and that Pohn discloses only vinyl decals applied to only a portion of an acrylic sheet.

Additionally, Cooledge fails to teach or suggest this element. Cooledge teaches applying a thin plastic film to an automobile window (col. 4, lines 37-54). However, Cooledge instructs that the film should be transparent as to "afford full vision of the road surface, allowing the driver to concentrate on driving while at the same time determining the direction in which he needs to drive. Therefore, in Cooledge objects on one side of the window *can be clearly distinguished from the other side of the window* by the driver.

Therefore, Cooledge specifically *teaches away* from the element that objects on either side of the window *cannot be clearly distinguished from the other side of the window*.

Therefore, since none of the seven references cited by the Examiner teach the above described element of claim 6, and furthermore *teach away* from the above described element, the Examiner has not established a prima facie case of obviousness. Claim 6 should be allowed.

Claims 23 and 26 are dependent on claim 4 and should be allowable for the reasons given above in support of claim 6 (claim 4 includes the same presently discussed feature of claim 6). Claim 26 has also been amended to clarify that a large amount of light passes through the window covering. Charley does not allow a large amount of light to pass through the window border because an opaque layer is added to the window border preventing a large amount of light to pass through the border.

Claim 27 is dependent on claim 6 and should be allowable for the reasons given above in support of its parent claim 6. Claims 29 and 31 are indirectly dependent on claim 27 and should be allowable for the reasons above in support of claim 27. Claim 29 has also been amended similarly as claim 26.

Claim 24 has been rejected under 35 USC § 103(a) on the basis of U.S. Patent No. 6,030,002 to Charley et al. (hereinafter Charley), in view of U.S. Patent No. 4,791,745 to Pohn (hereinafter Pohn) and U.S. Patent No. 4,582,232 to Cliffe (hereinafter Cliffe), further in view of U.S. Patent No. 6,054,208 to Rega et al. (hereinafter Rega) and GB2324381, and further in view of the advertisement for Solar Stat, and further in view of U.S. Patent No. 4,684,675 to Collier (hereinafter Collier).

The combination of Charley, Pohn, Taylor, Cliffe, Rega, GB 2324381, Solar Stat, and Collier fail to teach or suggest each and every element of claim 24. The combination of the references fails to teach at least the element of the film allowing light to pass through but diffusing it so that objects on either side of the window *cannot be clearly distinguished from the other side of the window*. The claimed process of producing a window covering results in a window covering that is specifically designed to allow light in but deny visibility from either side (see page 5 of the present specification, the last paragraph of the background section). Accordingly, claim 24 includes the feature that objects on either side of the window *cannot be clearly distinguished from the other side of the window* and this feature is neither taught nor suggested in any of the references.

Each and every one of the references fails to teach or suggest this important feature of claim 6. Charley, Taylor, Cliffe, Rega, Pohn, GB 2324381, and Solar Stat each fail to teach

or suggest this element for the reasons described previously in this response to office action with regard to previously discussed claims.

Additionally, Collier fails to teach or suggest this element. Collier does not even disclose a window. It is arguable whether Collier is even applicable prior art. Even if Collier is applicable prior art, Collier does not teach or suggest the element that objects on either side of the window *cannot be clearly distinguished from the other side of the window* for at least the reason that Collier does not discuss windows or views.

Therefore, since none of the seven references cited by the Examiner teach the above described element of claim 24, and furthermore *teach away* from the above described element, the Examiner has not established a prima facie case of obviousness. Claim 24 should be allowed.

Claim 25 has been rejected under 35 USC § 103(a) on the basis U.S. Patent No. 4,791,745 to Pohn (hereinafter Pohn) and U.S. Patent No. 4,582,232 to Cliffe (hereinafter Cliffe), further in view of U.S. Patent No. 5,672,413 to Taylor et al. (hereinafter Taylor) and further in view of U.S. Patent No. 5,617,790 to Chmielnik (hereinafter Chmielnik).

The combination of Pohn, Cliffe, and Taylor fail to teach or suggest each and every element of claim 25. The combination of the references fails to teach at least the element of the film allowing light to pass through but diffusing it so that objects on either side of the window *cannot be clearly distinguished from the other side of the window*. The claimed process of producing a window covering results in a window covering that is specifically designed to allow light in but deny visibility from either side (see page 5 of the present specification, the last paragraph of the background section). Accordingly, claim 25 includes the feature that objects on either side of the window *cannot be clearly distinguished from the other side of the window* and this feature is neither taught nor suggested in any of the references.

Each and every one of the references fails to teach or suggest this important feature of claim 25. Pohn, Taylor and Cliffe each fail to teach or suggest this element for the reasons described previously in this response to office action with regard to previously discussed claims.

Additionally, Chmielnik fails to teach or suggest this element. Chmielnik does not even disclose a window. It is arguable whether Chmielnik is even applicable prior art. Even if Chmielnik is applicable prior art, Chmielnik does not teach or suggest the element that objects on either side of the window *cannot be clearly distinguished from the other side of the window* for at least the reason that Chmielnik does not discuss windows or views.

Therefore, since none of the references cited by the Examiner teach the above described element of claim 25, and furthermore *teach away* from the above described element, the Examiner has not established a prima facie case of obviousness. Claim 25 should be allowed.

Claim 25 has been rejected under 35 USC § 103(a) on the basis of U.S. Patent No. 6,030,002 to Charley et al. (hereinafter Charley), in view of U.S. Patent No. 5,672,413 to Taylor (hereinafter Taylor) and in view of U.S. Patent No. 4,791,745 to Pohn (hereinafter Pohn) and U.S. Patent No. 4,582,232 to Cliffe (hereinafter Cliffe), further in view of U.S. Patent No. 6,054,208 to Rega et al. (hereinafter Rega) and GB 2324381, and further in view of the advertisement for Solar Stat, and further in view of U.S. Patent No. 5,617,790 to Chmielnik (hereinafter Chmielnik). This rejection is respectfully traversed.

The combination of Charley, Taylor, Pohn, Cliffe, Rega, GB 2324381, Solar Stat, and Chmielnik fail to teach or suggest each and every element of claim 25. The combination of the references fails to teach at least the element of the film allowing light to pass through but diffusing it so that objects on either side of the window *cannot be clearly distinguished from the other side of the window*. The claimed process of producing a window covering results in a window covering that is specifically designed to allow light in but deny visibility from either side (see page 5 of the present specification, the last paragraph of the background section). Accordingly, claim 25 includes the feature that objects on either side of the window *cannot be clearly distinguished from the other side of the window* and this feature is neither taught nor suggested in any of the references.

Each and every one of the eight references fails to teach or suggest this important feature of claim 25. Charley, Taylor, Pohn, Cliffe, Rega, GB 2324381, Solar Stat, and Chmielnik each fail to teach or suggest this element for the reasons described previously in this response to office action with regard to previously discussed claims.

Therefore, since none of the references cited by the Examiner teach the above described element of claim 25, and furthermore *teach away* from the above described element, the Examiner has not established a prima facie case of obviousness. Claim 25 should be allowed.

Claim 28 has been rejected under 35 USC § 103(a) on the basis of U.S. Patent No. 6,030,002 to Charley et al. (hereinafter Charley) in view of U.S. Patent No. 4,791,745 to Pohn (hereinafter Pohn), further in view of U.S. Patent No. 6,054,208 to Rega et al. (hereinafter Rega) and GB 2324381, and further in view of the advertisement for Solar Stat, and further in view of U.S. Patent No. 5,258,214 to Cooledge et al. (hereinafter Cooledge),



further in view of U.S. Patent No. 4,684,675 to Collier (hereinafter Collier). This rejection is respectfully traversed.

The combination of Charley, Pohn, Cliffe, Rega, GB 2324381, Solar Stat, Cooledge and Collier fail to teach or suggest each and every element of claim 28. The combination of the references fails to teach at least the element of the film allowing light to pass through but diffusing it so that objects on either side of the window *cannot be clearly distinguished from the other side of the window*. The claimed process of producing a window covering results in a window covering that is specifically designed to allow light in but deny visibility from either side (see page 5 of the present specification, the last paragraph of the background section). Accordingly, claim 25 includes the feature that objects on either side of the window *cannot be clearly distinguished from the other side of the window* and this feature is neither taught nor suggested in any of the references.

Each and every one of the eight references fails to teach or suggest this important feature of claim 25. Charley, Pohn, Cliffe, Rega, GB 2324381, Solar Stat, Cooledge and Collier each fail to teach or suggest this element for the reasons described previously in this response to office action with regard to previously discussed claims.

Therefore, since none of the references cited by the Examiner teach the above described element of claim 25, and furthermore *teach away* from the above described element, the Examiner has not established a prima facie case of obviousness. Claim 28 should be allowed.

Claim 30 has been rejected under 35 USC § 103(a) on the basis of U.S. Patent No. 6,030,002 to Charley et al. (hereinafter Charley) in view of U.S. Patent No. 4,791,745 to Pohn (hereinafter Pohn) and U.S. Patent No. 4,528,232 to Cliffe (hereinafter Cliffe), further in view of U.S. Patent No. 6,054,208 to Rega et al. (hereinafter Rega) and GB 2324381, and further in view of the advertisement for Solar Stat, and further in view of U.S. Patent No. 5,258,214 to Cooledge et al. (hereinafter Cooledge), further in view of U.S. Patent No. 5,617,790 to Chmielnik (hereinafter Chmielnik). This rejection is respectfully traversed.

The combination of Charley, Pohn, Cliffe, Rega, GB 2324381, Solar Stat, Cooledge and Chmielnik fail to teach or suggest each and every element of claim 30. The combination of the references fails to teach at least the element of the film allowing light to pass through but diffusing it so that objects on either side of the window *cannot be clearly distinguished from the other side of the window*. The claimed process of producing a window covering results in a window covering that is specifically designed to allow light in but deny visibility from either side (see page 5 of the present specification, the last paragraph of the background

section). Accordingly, claim 25 includes the feature that objects on either side of the window *cannot be clearly distinguished from the other side of the window* and this feature is neither taught nor suggested in any of the references.

Each and every one of the eight references fails to teach or suggest this important feature of claim 30. Charley, Pohn, Cliffe, Rega, GB 2324381, Solar Stat, Cooledge and Chmielnik each fail to teach or suggest this element for the reasons described previously in this response to office action with regard to previously discussed claims.

Therefore, since none of the references cited by the Examiner teach the above described element of claim 30, and furthermore *teach away* from the above described element, the Examiner has not established a prima facie case of obviousness. Claim 30 should be allowed.

#### *New claims*

New claims 32-35 have been added. Claims 32, 34 and 33, 35 are dependent on claims 4 and 6 respectively, and are therefore allowable for at least the same reasons as claims 4 and 6. Support for these new claims is disclosed in the present specification page 4, second paragraph, and page 5, in the first paragraph of the summary section discussing privacy and in the objects of the invention, object (h), and page 6, second paragraph, and page 7 fourth paragraph in the description of Figure 3.

New claims 36-41 have been added. Claims 36 and 37 are dependent on claims 4 and 6 respectively, and are therefore allowable for at least the same reasons as claims 4 and 6. Claims 38-41 are also allowable. Support for these new claims is disclosed in the present specification page 4 last sentence continued to page 5 and also on page 8, fifth paragraph.


New claims 42-49 are also allowable for at least similar reasons as claim 4. Support for these new claims is disclosed in the present specification on page 2, fourth paragraph, page 2, figure 3, page 6, third paragraph, page 4, last paragraph, page 4, third paragraph, page 6, second paragraph, page 4, first paragraph, page 7, fifth paragraph, and page 5, second paragraph.

***Conclusion***

The application is in condition for allowance and such action is respectfully requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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